

REMARKS

By this amendment, Applicants amend claims 1 and 9 to more appropriately define the invention. Claims 1-20 are currently pending.

In the last Office Action, the Examiner rejected claims 1 and 9 under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. The Examiner rejected claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,848,373 (hereinafter "DeLorme"). Applicants respectfully traverse the rejection to claims 1-20.

REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Applicants have amended claims 1 and 9 to overcome the Examiner's rejection by replacing the term "annotating a point," which the Examiner had objected to, with recitations which have clear support in the originally-filed application. Accordingly, Applicants respectfully request the Examiner to withdraw this rejection of claims 1 and 9.

REJECTION UNDER 35 U.S.C. § 102(b)

Anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference. To establish inherency, the Office must show that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the relevant art.

DeLorme discloses a computer aided map location system (CAMLs), which provides correlation and coordination of spatially related data between a computer

(PDA/PC/EC) and a set of printed maps typically printed on paper depicting surface features at desired levels of detail. See DeLorme, Abstract. A user enters a current location and a proposed destination, and then queries the system for a route from the current location to the proposed destination. The user does not mark a point on the raster map and a point on the georeferenced map because both points (start/destination) are on the same map. Therefore, DeLorme fails to anticipate the present invention, because DeLorme does not disclose each and every element of claim 1, including, at least “displaying a raster map and a georeferenced map, wherein the raster map and the georeferenced map are separate maps . . . [and] marking a first point on the georeferenced map.”

The Examiner further alleges that “[t]he step of determining a mathematical relationship between the image coordinates and the geographic coordinates is inherent because the user marks the origin and destination on the map.” Final Office Action, pg. 5. Applicants respectfully disagree.

To properly show that this element is inherent in DeLorme, the Examiner must cite extrinsic evidence, that describes the inherent element. See M.P.E.P. § 2131.01(III) (8th Ed. 2001). “Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that would be recognized by persons of ordinary skill.” Id. Inherency, however, may not be established by probabilities or possibilities. See M.P.E.P § 2163.07(a)

The Examiner provides evidentiary basis to support the inherency allegation. Further, even if such evidence were to be provided, these teachings would not be inherent in DeLorme, because a user in DeLorme does not mark a point on the raster

map and a point on the georeferenced map, since both points (start/destination) are on the same map. For example, because there are no marked points on the georeferenced map, there are no associated geographic coordinates from which a mathematical relationship may be determined. Therefore, DeLorme fails to anticipate claim 1 for this reason as well.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 1, as well as the rejection of claims 2-8 based on at least their dependency upon allowable independent claim 1.

Similarly, independent claim 9 recites features generally corresponding to those of claim 1 and patentably distinguishes over DeLorme for the same reasons as explained in claim 1. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 9, as well as the rejection of claims 10-20 based on at least their respective dependency upon allowable claims 1 and 9.

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-20 in condition for allowance. Applicants submit that the proposed amendments of claims 1 and 9 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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